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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,046	02/13/2004	Matthew Lerner	003797.00739	3923
28319 7590 02/23/2007 BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER TSUI, WILSON W	
			ART UNIT 2178	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/777,046

Applicant(s)

LERNER ET AL.

Examiner

Wilson Tsui

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 5-7, 9, 10, 13, 15, 16, 19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 5-7, 9, 10, 13, 15, 16, 19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the RCE filed on: 12/01/2006.
2. Claims 5, 6, 7, 9, 15, 19, 21, 22, 23, 24, and 26 have been amended. Claims 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26 are pending.
3. The 35 USC 112 rejection with respect to claim 6, has been withdrawn.
4. Prior 35 USC 102(e) rejections for claims 5-7, 9, 10, 13, 15, 16, 19, 23-26 as being anticipated by Madduri, are withdrawn.
5. Prior 35 USC 103(a) rejections for claim 2 as being unpatentable over Madduri, in further view of Schilit et al, and for claims 21 and 22 as being unpatentable over Madduri, in further view of Wilcox et al, are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 7, which depends on claim 23, the limitation "a static image of the first content associated with the annotation, wherein the first content changes over time" is not clear, since a static image of the first content, is an image that does not change over time. Yet, the limitation of claim 7 further includes the first content changing over time, and thus, it appears the image of the first content can not be static.

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With regards to claim 22, which depends on claim 21, recites the limitation "the first and second regions" in lines 4 and 5 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 13, and 19 rejected under 35 U.S.C. 102(e) as being anticipated by Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998).

With regards to claim 13, Price et al teaches a method comprising:

Receiving data regarding an annotation (column 5, lines 3-25: whereas, sets of ink annotations are received)

Storing a link to context information with said annotation data in a storage (column 6, lines 3-20: whereas, links to context information are stored through link databases)

Storing associations regarding at least two documents from which said annotation originates (column 6, lines 1-20: whereas association data between annotations, and one or more pages are stored).

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Wherein selection of said annotation accesses the at least two documents to display said annotation (column 5, lines 31-39: whereas, a particular annotation is selected, and multiple documents are accessed as shown in Figure 4 to display said annotation.)

With regards to claim 19, for a for a computer readable medium, having a program stored thereon, Price et al teaches:

Receiving data regarding an annotation, storing a link to context information with said annotation data in a storage, storing associations regarding at least two documents from which said annotation originates, wherein selection of said annotation accesses the at least two documents to display said annotation, as similarly explained in the rejection for claim 13, and is rejected under similar rationale.

Additionally, Price et al teaches *the at least two sets being from non-contiguous portions of a document or portion of different documents* (column 5, lines 31-43: whereas, at least two sets of annotations (each set of anchored ink marks are retrieved, based on the type of annotation/ink-anchor selected, as shown in Figure 4: whereas, multiple sets of anchored ink marks and their related content are retrieved.))

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 10, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun.

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15, 1998), in further view of Madduri (US Patent: 6,551,357 B1, issued: Apr. 22, 2003, field: Feb. 12, 1999).

With regards to claim 9, Price et al teaches a method comprising:

Receiving at least two sets of an annotation and related content, the at least two sets being from non-contiguous portions of a document or portions of different documents (column 5, lines 31-43: whereas, at least two sets of annotations (each set of anchored ink marks are retrieved, based on the type of annotation/ink-anchor selected, as shown in Figure 4: whereas, multiple sets of anchored ink marks and their related content are retrieved.)

Combining said at least two sets to from a combination consisting of non-contiguous portions of a document or portions of different documents or both (Figure 4: whereas, a combination of at least two sets of anchored ink marks, are combined and displayed on the screen (the at least two sets of anchored ink marks are non-contiguous since one set appears on page 4, and the other set appears on page 17).

However, Price et al does not expressly teach *filtering said combination of said at least two sets, displaying the filtered combination of said at least two sets*.

Madduri et al teaches *filtering said combination of said at least two sets, displaying the filtered combination of said at least two sets* (column 8, lines 31-35, and column 8, lines 37-44: whereas a user can view a combination of annotated sets (whereas the sets are combined into a pool of annotated sets due to selecting a plurality of markup files), and further filter the collective combination to block certain sets for viewing).

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It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al's set combination, such that the combination can be filtered, as taught by Madduri et al. The combination of Price et al, and Madduri et al would have allowed Price et al to have allowed users to "have selectively displayed markings generated from other people without altering the underlying text document" (Madduri et al, column 3, lines 16-20).

With regards to claim 10, which depends on claim 9, Madduri et al teaches *filtering said combination of said at least two sets*, as similarly explained in the rejection for claim 9, and is rejected under similar rationale. Madduri et al further teaches the *filtering*, further includes retrieving the combination data from a file (column 8, lines 1-7: whereas the video controller retrieves selected/filtered combination data from a file).

With regards to claim 15, for a computer readable medium, having a program stored thereon, that performs a method similar to claim 9, is rejected under similar rationale.

With regards to claim 16, for a computer readable medium, having a program stored thereon, that performs a method similar to claim 10, is rejected under similar rationale.

9. Claims 5-7, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), in further view of Wilcox et al (US Patent: 5,592,568, issued: Jan.7, 1997, filed: Feb. 13, 1995).

With regards to claim 21, Price et al teaches a system comprising:

An input for receiving annotations associated with content, as similarly explained in the rejection for claim 13, and is rejected under similar rationale.

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A processor for creating a renderable image having clips, wherein at least one of said clips is a combination of two or more annotations and their associated content (Figure 4: whereas a clip includes two annotations and associated content), said processor executing instructions including:

Encompassing first content and an associated annotation in a first bounding box (Figure 4: whereas, first content and associated annotation is retrieved for a particular page (page 4 in the figure), such that a first bounding box is implemented).

Encompassing second content and an associated annotation in a second bounding box (Figure 4: whereas second content and associated annotation is retrieved for a particular page (page 7 in the figure), such that a second bounding box is implemented), *wherein the first and second bounding boxes are non-contiguous* (Figure 4: whereas, the first and second bounding boxes, bound content and annotations from different pages)

Outputting said renderable image (Figure 4: whereas a combination of clips are output for display in a renderable image/display-image-clip).

However, Price et al does not expressly teach *combining* the first bounding box, *and* the second bounding box to form one of said clips.

Wilcox et al teaches *combining the first bounding box, and the second bounding box to form one of said clips* (Abstract: whereas, bounding boxes enclose image objects based on markings/word shape). Additionally, Wilcox et al teaches combining bounding boxes should the threshold between their neighbors are within a threshold distance from each other in a document (column 19, lines 49-54).

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It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al's first and second bounding boxes, such that they can also have been combined to form a clip, as taught by Wilcox et al. The combination of Price et al and Wilcox et al would have allowed Price et al to have "recognized keywords /strings (combination of smaller entities) without having to detect or recognize individual characters making up the strings (thus ultimately processing less entities)" (Wilcox et al, column 1, lines 49-51).

With regards to claim 22, which depends on claim 21, Price et al and Wilcox et al similarly teach *prior to combining the processor executes instructions which determine that the first bounding box and the second bounding box are within a threshold distance from each other in a document*, as similarly explained in the rejection for claim 21, and is rejected under similar rationale.

Additionally, Price et al also teaches *wherein third content without an associated annotation is located in a third region located between the first and second regions* (column 3, lines 65-67, Figures 6A, and 6B: whereas content includes removal of associated annotation(s), and also omitted regions in between a first and second region are shown in Figure 4.)

With regards to claim 23, for a system performing a method similar to the method performed by the system of claim 21, is rejected under similar rationale.

With regards to claim 24, for a system performing a method similar to the method performed by the system of claim 22, is rejected under similar rationale.

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With regards to claim 5, which depends on claim 23, Price et al teaches *wherein a storage storing said annotation and an image of the first content associated with the annotation* (column 5, lines 59-67, and column 6, lines 1-20: *whereas, images, which include the first content associated with the annotation, and the ink annotation, is stored in a database*).

With regards to claim 6, which depends on claim 23, Price et al teaches *a storage storing said annotations and a link to said content* (column 6, lines 1-20).

With regards to claim 7, which depends on claim 23, Price et al teaches *a storage storing said annotations and a static image of the first content associated with the annotation, and wherein the first content changes over time* (column 6, lines 1-20: *whereas the first content includes ink strokes from the time of the beginning of a sequence ink points, till the end of the sequence of ink points over time*).

With regards to claim 25, which depends on claim 6, Price et al teaches *wherein said annotations are from different documents* (Figure 4: *whereas, annotations are from different pages/documents (pages 4 and 7)*).

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), and Wilcox et al (US Patent: 5,592,568, issued: Jan. 7, 1997, filed: Feb. 13, 1995), in further view of Schilit et al (US Patent: US 6,279,014 B1, issued: Aug. 21, 2001, filed: Sep. 15, 1997).
With regards to claim 2, which depends on claim 23, Price et al and Wilcox et al teaches *wherein said at least one of said clips*, as explained in the rejection for claim 23, and is rejected under the same rationale.

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However, Price et al and Wilcox et al do not expressly teach wherein said clips *includes additional content*.

Schilit et al teaches *clips containing additional content*: whereas each clip comprises a context portion (Schilit et al, column 6, lines 45-50), and addition content information, such as attributes concerning the type (column 7, lines 23-26), identified content (column 7, lines 27-30), or time/date data (column 7, lines 35-39).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al, and Wilcox et al's clips, such that they contain the additional information, as taught by Schilit et al. The combination would have allowed Price et al to have implemented "an annotation system for electronic documents ... with quick accessibility" (Schilit et al, column 3, lines 10-15)

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), and Wilcox et al (US Patent: 5,592,568, issued: Jan. 7, 1997, filed: Feb. 13, 1995), in further view of Madduri et al (US Patent: 6,551,357 B1, issued: Apr. 22, 2003, filed: Feb. 12, 1999)

With regards to claim 26, Price et al and Wilcox et al teach *said documents* (as similarly explained in the rejection for claim 23, and is rejected under similar rationale). However, Price et al, and Wilcox et al do not expressly teach said documents *are from different application programs*.

Madduri et al teaches *said documents are from different application programs* (column 5, lines 1-16: whereas documents are from different programs such as WordPerfect, and Microsoft Word).

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It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al and Wilcox et al's system, such that the system uses documents from different application programs, as taught by Madduri et al. The combination of Price et al, Wilcox et al, and Madduri et al would have allowed Price et al to have implemented a system with documents "having text in any text format known in the art" (Madduri et al, column 5, lines 6-8).

Response to Arguments

12. Applicant's arguments with respect to claims 2, 5-7, 9, 10, 13, 15, 16, 21-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

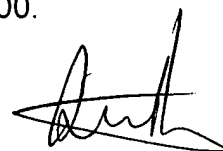
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

W. T. 2/15/07

Wilson Tsui
Patent Examiner
Art Unit: 2178
February 15, 2007



STEPHEN HONG
SUPERVISORY PATENT EXAMINER